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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,414	01/08/2002	Michael Joseph Calderaro	AUS920010786US1	1316

40412 7590 12/30/2005

IBM CORPORATION- AUSTIN (JVL)
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EXAMINER	
LE, NANCY LOAN T	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,414	CALDERARO ET AL.	
	Examiner	Art Unit	
	NANCY LOAN T. LE	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6,8,9,11-15 and 17-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 4-6, 8-9, 11-15, and 17-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is responsive to amendment filed on 06 October 2005 in which no claims are amended, added or cancelled. Claims 1-2, 4-6, 8-9, 11-15, and 17-19 are currently present in the application, and claims 1, 8, and 14 are independent claims.

Response to Arguments

Applicants' arguments filed 10/06/2005 have been fully considered but they are not persuasive.

(1) Applicants argue (argument pages 2, 3, 5) that the Examiner is not using the correct definition of non-functional descriptive material. That is all the claim limitations, including the limitations pertaining to a "*surplus reduction action*," an "*employee*," a "*surplus acknowledgement*," a "*user identifier*," and "*benefits data*" must be considered when determining whether the claims are non-obvious in view of the prior art.

Furthermore, Applicants argue that the surplus reduction action, the employee, the surplus acknowledgement, the user identifier, and the benefits data claimed by Applicants are **not** non-functional descriptive material, but rather are a necessary part of the functional and structural relationship claimed in claims 1, 8, and 14 . As claimed, the surplus reduction on action describes exactly what is received from a user. The user is an employee, and the surplus reduction action includes a surplus acknowledgement. Each user has a user identifier, which is stored along with data corresponding to the surplus reduction action. Benefits data is then provided to the employee . These elements are an integral part of Applicants' claims, and define the metes and bounds of Applicants' claimed invention.

In response, the Examiner respectfully disagrees with Applicants because the "*surplus reduction action, the employee, the surplus acknowledgement, the user identifier,* and *the benefits data* claimed by Applicants are indeed "*non-functional descriptive material*".

The "surplus reduction action", wherein the surplus reduction action includes a "surplus acknowledgment", the "user" is an "employee", "user identifier", and the "benefits data", and so on, which qualify as *descriptive material* since **they are directed to the *content of data*, not structure, or an**

action, or step. Such content of data (i.e., descriptive material) **is not functionally involved** in the recited steps. In the Examiner's view, the steps of **receiving** <an input/request/anything from a user/employee/anybody/etc.>, **identifying** <a user identifier – i.e., identification information about a user from whom an input/data is sent such as user's name, ID, logon ID, etc.>, **providing** <benefit data, or any desired data to the user, in response to the user's input> (claim 1), however, do **not depend on** the content of "the surplus reduction action", "surplus acknowledgment", "benefits data", etc., or any data in general, and **are done/performed the *same* regardless how this descriptive material/data is being used, i.e., regardless of the user's input/request/data**. Therefore, the method has ***not*** changed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include **any type of information/data in the user's request/input** in the "**receiving, identifying, providing, storing**, etc." steps, as taught by Wheeler et al. ***because the subjective interpretation of what is being included in the user's request/input (i.e., data), do not patentably distinguish*** the claimed method.

Further, the recited steps of "**receiving, identifying, providing, storing**, etc. <data>" are categorized as the basic input/output process which stores/saves/maintains/keeps track, etc. data received/sent from the parties involved in the process, and is well-known in the art.

In conclusion, such data, i.e., descriptive material, does **not *functionally* relate to** the steps recited in the claimed method(s)/invention, and therefore, **will not distinguish** the claimed method(s) from the prior art in terms of ***patentability***.

(2) Applicants argue (argument pages 5 and 6) that the prior art simply does not teach or suggest the elements claimed by Applicants in independent claims 1, 8, and 14. For example, the purchase order disclosed in Wheeler is not analogous to the surplus reduction action or the surplus acknowledgement that is taught and claimed by Applicants.

Providing an invoice in response to receiving a purchase order is not analogous to providing benefits data to an employee. Wheeler has absolutely nothing to do with tracking surplus reduction actions, as taught and claimed by Applicants, and therefore, can not be used to support an obviousness rejection of Applicants' claimed invention.

In response, the Examiner respectfully disagrees with Applicants because although Wheeler et al. have nothing to do with dealing with 'surplus reduction actions', but by receiving a purchase order from a customer {who is an employee of a business/company}, identifying whether or not the customer is authorized to place a purchase order on his/her company's behalf {and of course, identifying <the customer's name, and with what company/business that he/she is associated with, etc. – i.e., customer/user's identity/identifier>}, and up to how much he/she is authorized to order, etc., and providing an invoice {as an acknowledgement/confirmation of the purchase order} in response to receiving the purchase order to the customer, storing information related with the purchase transaction that is received/sent from the involved parties, and so on, do constitute the same act of "**receiving, identifying, providing, storing**, etc. <data>" as taught and claimed by Applicants. Obviously, Wheeler et al. offer the same solution to the same problem of storing/saving/maintaining/tracking/etc. data received/sent from the parties involved in the purchase transaction process, or in any process in general. Therefore, in view of this, Wheeler et al. disclosure is considered *analogous* to the surplus reduction action that is taught and claimed by Applicants; thus, can be used to support an obviousness rejection of Applicants' claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday-Thursday, 7am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES P. TRAMMELL can be reached on **(571) 272-6712**. ***For official/regular communication***, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**. ***For informal/draft communication***, the fax number is **(571) 273-7066 (rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free).**

Any response to this action should be *mailed* to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Hand-delivered responses should be brought to:

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401 Dulany Street

Alexandria, VA 22314

NL

27 December 2005

Primary Examiner
Au 3621